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10/569,873

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EXAMINER

BIANCHI, KRISTIN A

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

12/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/569,873 | Applicant(s) CHENG ET AL. | |
| | Examiner KRISTIN BIANCHI | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 11-24, 26-28 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 16-18, 21, 22, 24 and 28 is/are rejected.
- 7) ☒ Claim(s) 11-15, 19, 20, 23, 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 11-24, 26-28, and 30-35 are pending in the instant application. Claims 30-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected subject matter. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other. Claims 1, 16-18, 21, 22, 24, and 28 are rejected. Claims 11-15, 19, 20, 23, 26, and 27 are objected.

Response to Amendment and Arguments/Remarks

The amendment and arguments/remarks filed on July 30, 2009 have been fully considered and entered into the application. In regards to the 35 U.S.C. 112, first and second paragraph, rejections of claims 1-29 and claim 25, respectively, the grounds for rejection are moot in view of Applicant's amendment and the rejections have been withdrawn. In regards to the 35 U.S.C. 102(b) rejections of claims 1-10, 15-18, 21-23, and 25 as being anticipated by WO 99/52906; claims 1-7, 9, 10, 15-18, 21, 22, and 28 as being anticipated by Soliman et al.; claims 1-11, 15-18, 21, 22, 24, and 28 as being anticipated by Ashton et al.; claims 1-10, 15-18, 21, 22, and 24 as being anticipated by Beilstein Registry No. 8640850; and claims 1-7, 9-11, 15-18, 21, and 22 as being anticipated by Patent Compound Registry No. 1495354, the grounds for rejection are moot in view of Applicant's amendment and the rejections have been withdrawn. In regards to the 35 U.S.C. 102(b) rejection claims 1, 2, 4-10, 16-18, 21, 22, 24, and 28 as being anticipated by WO 02/06246, Applicant argues that the pending claims would

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require that the pyrimidinyl moiety in WO 02/06246 not have a carboxyl group. This argument is not found to be persuasive because as disclosed in the Office Action dated April 30, 2009, the compound disclosed in the WO 02/06246 anticipates a compound of the instant claims, specifically a compound of formula III, wherein ring A or W is phenyl, E is CH₂, G is NH, and R₃ or R₃₀ is a substituted heterocyclyl. In other words, the carboxyl substituted pyrimidinyl group in WO 02/06246 is R₃ or R₃₀ in the instant claims (i.e., not ring A or W). Therefore, the rejection is maintained and described below. In regards to the rejection of claims 16-18, 21, 22, and 28 as being anticipated by Auzou et al., Applicant argues that Auzou et al. requires that the phenyl moiety of R₃ not be substituted. This is also not found to be persuasive because as disclosed in the previous Office Action, the rejection over Auzou et al. referred to the compound wherein one of R₁, R₂ or R₃ is OCHMeCONH-pCl-C₆H₄ with no other substitution on the Ph ring and this compound anticipates a compound of the instant claims wherein R₃₀ is halogen (i.e., Cl). Therefore, the rejection is maintained and described below.

Maintained Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 16-18, 21, 22, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/06246.

Specifically, WO 02/06246 discloses compounds which are used in pharmaceutical compositions (i.e., abstract), such as the compound of example number 99 (Table 1, page 53) which anticipates a compound of the instant claims or a compound of formula III wherein W is phenyl, E is CH₂, G is NH, and R₃₀ is substituted heterocyclyl.

Claims 16-18, 21, 22, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Auzou et al. (European Journal of Medicinal Chemistry (1984), 19(3), 283-4).

Specifically, Auzou et al. discloses compounds which are used in pharmaceutical compositions (i.e., abstract), such as a compound wherein one of R₁, R₂ or R₃ is OCHMeCONH-pCl-C₆H₄ with no other substitution on the Ph ring which anticipates a compound of the instant claims or a compound of formula III wherein E is O, G is C(R₃₁)R₃₂ wherein R₃₁ or R₃₂ is hydrogen with the other being methyl, R₃₀ is halogen, W is pyrrole, and R₂₇ is methyl.

Claim Objections

Claims 11-15, 19, 20, 23, 26, and 27 are objected for depending on a previous rejected claim. However, even if the claims are amended to be in independent form, they would still not be in condition for allowance because they contain non-elected subject matter (i.e., B and C are not limited to phenyl). In other words, the subject matter or species which are not embraced by the elected embodiment or the identified (i.e., in the previous Office Action) nonelected species (i.e., compounds other than compounds of formula III) have been withdrawn from further consideration.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/
Primary Examiner, Art Unit 1626

Kristin Bianchi
Examiner
Art Unit 1626
